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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,648	12/30/2003	Benad Goldwasser	1382GIV-US	5754
20741	7590	11/15/2005		
HOFFMAN WASSON & GITLER, P.C CRYSTAL CENTER 2, SUITE 522 2461 SOUTH CLARK STREET ARLINGTON, VA 22202-3843			EXAMINER FOREMAN, JONATHAN M	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/747,648

Applicant(s)

GOLDWASSER ET AL.

Examiner

Jonathan ML Foreman

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 5-9 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 10-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/05; 3/05; 10/05</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statements filed 1/28/05, 3/23/05 and 10/21/05 comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. The information disclosure statements have been placed in the application file, and the information referred to therein has been considered by the examiner as to the merits.

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention: Species I directed to a gastrointestinal tool comprising a radioactive device; Species II directed to a gastrointestinal tool comprising an iontophoresis drug delivery device; Species III directed to a gastrointestinal tool comprising an injection device; Species IV directed to a gastrointestinal tool comprising a photodynamic therapy/diagnosis device; Species V directed to a gastrointestinal tool comprising a hyperthermic therapy/diagnosis device; Species VI directed to a gastrointestinal tool comprising an ultrasonic therapy/diagnosis device; and Species VII directed to a gastrointestinal tool comprising an imaging device.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 – 3 and 10 – 13 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Art Unit: 3736

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Martin Hoffman on 11/10/05 a provisional election was made *with* traverse to prosecute the invention of Species I directed to a gastrointestinal tool comprising a radioactive device, claims 1 – 4 and 10 - 13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 5 – 9 and 14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

Claim 4 is objected to because of the use of "comprising" in relation with the Markush group. Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925). It is improper to use the term "comprising" instead of "consisting of." *Ex parte Dotter*, 12 USPQ 382 (Bd. App. 1931). See MPEP 2173.05(h).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3 and 10 – 12 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,395,332 to Ressemann et al.

In regards to claims 1, 3 and 10 – 12, Ressemann et al. discloses a gastrointestinal apparatus (Figure 12) including a guidewire (78A); and a gastrointestinal tool including a guiding member (176) formed with a bore (245), the guidewire (78A) passing through the bore. Ressemann et al. discloses the guiding member being positioned outside an outer contour of the gastrointestinal tool (Figure

Art Unit: 3736

12). Ressemann et al. discloses a propulsion device (138) to propel the tool along the guidewire and an anchoring device comprising an inflatable balloon (62).

6. Claims 1, 2, 4 and 10 – 12 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,863,284 to Klein.

In regards to claims 1, 2, 4 and 10 – 12, Klein discloses a gastrointestinal apparatus (Figure 4) including a guidewire (GW); and a gastrointestinal tool including a guiding member formed with a bore (20), the guidewire passing through the bore (Col. 15, line 57 – Col. 16, line 3). Klein discloses the guiding member being positioned inwards of an outer contour of the gastrointestinal tool (Col. 15, line 57 – Col. 16, line 3). Klein discloses the tool being a radioactive device selected from the group consisting of a radioactive tube, radioactive needle, radioactive see, and radioactive capsule (Col. 13, lines 11 – 12). Klein discloses a propulsion device to propel the tool along the guidewire (Col. 12, lines 55 – 59) and an anchoring device (32) comprising an inflatable balloon.

7. Claims 1, 2, 10 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Application Publication No. 2003/0208219 to Aznoian et al.

In regards to claims 1, 2, 10 and 13, Aznoian et al. discloses a gastrointestinal apparatus (Figure 4 – 4C) including a guidewire [0045][0050]; and a gastrointestinal tool (300) including a guiding member formed with a bore [0045], the guidewire passing through the bore [0045]. Aznoian et al. discloses the guiding member being positioned inwards of an outer contour of the gastrointestinal tool [0045][0050]. Aznoian et al. discloses a propulsion device to propel the tool along the guidewire [0050] and the tool being coupled to a pulley [0045].

Art Unit: 3736

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JMLF



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